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Paper No. 33
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Elan Line, tovarna sportnih izdelkov, d.o.o., by change of
name from Elan Ski, podjetje za proizvodnjo smuci, d.o.o.,
and Elan, podjetje za ustanavljanje, financiranje in
upravljanje z drugimi podjetji, d.d.

v.

Equipment De Sport, U.S.A.

Opposition No. 108,409
to application Serial No. 75/175,608
filed on October 3, 1996

Marsha G. Gentner and Brian B. Darville of Jacobson, Price,
Holman & Stern, Pllc for Elan Line, tovarna sportnih
izdelkov, d.o.o., by change of name from Elan Ski, podjetje
za proizvodnjo smuci, d.o.o., and Elan, podjetje za
ustanavljanje, financiranje in upravljanje z drugimi
podjetji, d.d.

Stuart C. Burr and Equipment De Sport, U.S.A. Inc., pro se.

Before Seeherman, Quinn and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Elan Line, tovarna sportnih izdelkov, d.o.o., by change
of name from Elan Ski, podjetje za proizvodnjo smuci,
d.o.o., and Elan, podjetje za ustanavljanje, financiranje in
upravljanje z drugimi podjetji, d.d., (hereafter,

respectively, Elan Line and Elan, or opposers) have opposed the application of Equipment De Sport, U.S.A. to register ELAN BLANC as a trademark for "clothing, outerwear and accessories for men, women, children and infants; namely, caps, cowls, ear-muffs, ear warmers, gloves, hats, headbands and other headwear, ski masks, neck warmers, scarves and suspenders."¹ The application claims first use and first use in commerce as of November 11, 1982; ELAN BLANC is translated as "white elk."

Opposers have brought their opposition on the ground of likelihood of confusion, alleging, essentially, that they are related corporations; that they own registrations and are prior users in the United States of the mark and trade name ELAN for ski sports and athletic equipment and accessories.

Applicant denied all the salient allegations in the notice of opposition, and asserted four "affirmative defenses" which are, in fact, merely further explanations of its denial of the allegation of likelihood of confusion, to wit: the marks are dissimilar; the goods are dissimilar; opposers' mark is weak; and the parties' marks have been concurrently used without any evidence of actual confusion.

The record includes the pleadings, and the file of the opposed application. Although applicant did not submit any

¹ Application Serial No. 75/176,608, filed October 3, 1996.

evidence, opposers submitted the testimony, with exhibits, of Robert G. Orbacz, the President and CEO of Monark Sporting Goods, Inc., a wholly-owned subsidiary of Elan.² Opposers also made of record applicant's answers to certain of opposers' interrogatories, requests for admission, and requests for production of documents³; the discovery depositions, with exhibits, of Stuart Burr and Sheri Burr; copies of pages from certain printed publications (most of which were also submitted as exhibits to the Orbacz testimony deposition); and status and title copies of opposers' pleaded registrations, showing that Elan is the owner of the following marks for the identified goods:

for "winter and water skis; ski poles; hockey sticks; indoor clubs; ball targets, sleds of the non-motorized type; boards; hoops and mats; volleyball nets and net stands; gymnastic apparatus—namely, horizontal bars, rings, parallel bars, balancing forms, benches, horses, spring boards, mats, wall bars, ladders, poles, ropes, wands, hoops, apparatus for the performance of hand stands and slalom exercises,

² It is noted that opposers submitted under seal Orbacz exhibit 3, a customer list, but did not mark as confidential nor segregate from Mr. Orbacz's testimony deposition his testimony concerning specific customers of Monark.

³ Although documents produced pursuant to FRCP 34 cannot be made of record under a notice of reliance, see Trademark Rule 2.120(j)(3)(ii), in this case opposers have submitted the responses to show that applicant has no such documents. Accordingly, we have considered the responses to be in the nature of responses to interrogatories.

weights, rubber expanders, utilized for the exercise of muscles by drawing against tension"⁴; and

for "gymnastic, athletic, sporting and playground equipment--namely, horizontal, parallel and fixed-wall bars, vaulting boxes and horses, footstools, springboards, balance beams; gymnastic/exercise bench, skip ropes, climbing ropes, rubber ropes, leather balls, medicine balls, ball targets, ball cases; flat boards, inclined boards, abdominal boards; exercise equipment in the nature of rubber expander; body and leg weight belts; slalom training poles; snow skis, water skis, ski poles, hockey sticks, and sleds; athletic ladders, including gym, lattice, and rope ladders; climbing and vaulting poles; rings; volleyball equipment--namely, standard net; basketball equipment--namely, hoops, wall support and backboard; table tennis equipment--namely, table and net; handball equipment--namely, goal and net; tennis net; weightlifting equipment--namely, weights, bars, weight stands, plinth and dumbbells; outdoor playground equipment--namely, swings, climbing rings and ladders, merry-go-round, simulated train engine, bridge, seesaw, slide, sandbox, and tent; jumping and lattice hurdles; and gymnastic equipment--namely, cylinders, cubes and prisms, all of the above in Class 28."⁵

The registration for this mark indicates that "elan" may be translated from French to mean "ardour, impetus and dash."

Applicant did not submit any evidence, although the discovery materials opposers made of record have provided substantial information about applicant's activities.

⁴ Registration No. 949,235, issued December 26, 1972; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

⁵ Registration No. 1,265,092, issued January 24, 1984; Section 8 affidavit accepted; Section 15 affidavit received.

The parties have fully briefed the case,⁶ but an oral hearing was not requested.

In its brief applicant has argued affirmative defenses based on various theories of estoppel. As opposers point out, such defenses were never raised by applicant in its pleading nor, since applicant took no testimony, can we treat the defenses as having been tried and therefore deem the pleadings to have been amended pursuant to Fed.R.Civ.P. 15(b). Accordingly, these defenses have been given no consideration.⁷

Opposers' ground for this opposition is the claim of priority and likelihood of confusion. The record shows that opposers are Slovenian companies which sell skis and

⁶ Applicant submitted, in addition to its trial brief, an amended brief which is, in effect, a second brief which contains argument on points not advanced in the initial brief. Although the trademark rules do not provide for such a second brief, because both briefs were timely filed, the amended brief being filed just 7 days after the initial brief, and because the two briefs, combined, do not exceed the page limit for a trial brief, both of applicant's briefs have been considered. Applicant attached to its amended brief two "exhibits," to which opposers objected. Exhibit 2 was made of record by opposers as part of the discovery deposition of Stuart Burr. However, Exhibit 1 was not properly made of record during applicant's testimony period, and therefore it has not been considered.

Opposers, in their reply brief, state that many of the "facts" asserted in applicant's brief are not supported by the record. We note that much of the information discussed by applicant was put into evidence by opposers through the discovery depositions of Mr. and Ms. Burr. However, we agree that there are statements in the brief which are not supported by any evidentiary submissions, for example, that "within the ski and sporting goods industry, there are a multitude of names that relate to ski, sport, snow, mountains, elk, deer, etc." Such unsupported assertions have not been considered.

⁷ Even if the defenses had been considered, the evidence of record does not support applicant's claims.

snowboards and related accessories in the United States through their wholly-owned subsidiary and exclusive wholesale distributor, Monark Sporting Goods, Inc. (hereafter Monark). Monark distributes opposers' products to sporting goods stores, ski stores, ski rental shops, ski resorts, and skateboard and surf shops, which in turn sell or rent the products to the general public. Skis bearing the ELAN trademark have been sold in the United States since 1977, and snowboards bearing the mark have been sold since 1994. Each year Monark imports between 70,000 and 130,000 pairs of ELAN skis, and between 2,000 and 6,000 snowboards. Monark provided sales figures from 1989 to 1999 for ELAN skis, ski poles and related "soft goods" (apparel items such as hats and sweatshirts); more than 90% of the figures represent its sales of skis. Sales during this period amounted to \$111.5 million, ranging from \$7.3 to \$15.5 million per year. Sales of ELAN snowboards since their introduction in the United States in 1994 have amounted to \$5.6 million. ELAN skis have the third-highest market share for ski sales in the United States, and the largest market share for ski rentals.

Monark promotes the ELAN products in a number of ways. It advertises ELAN skis and snowboards in magazines such as "Ski," "Skiing," "Powder" and "Freeze". The annual

placement costs for this advertising were in excess of \$1 million in the 10-year period from 1989 to 1999. Monark also provides advertising materials so that retailers can place advertisements in local papers. Monark exhibits in the national SIA trade show, and buying group shows, and its manufacturers' reps participate in regional trade shows. Monark also distributes 5,000 dealer brochures and 100,000 consumer brochures each year, and provides point of purchase displays, banners and posters.

Opposers sponsor various champion skiers, and typically, when they win a race, they are photographed holding their skis so that the ELAN mark appears near their faces. Magazines and television will carry these images.

In addition to these promotional efforts, the ELAN mark has achieved a great deal of publicity because opposers were the first to sell a parabolic or shaped ski in 1994. Articles reporting on this development, and featuring the ELAN skis, have appeared in various newspapers and magazines, including "The Wall Street Journal" and "Newsweek," as well as on segments on the television programs "The Today Show" and "Good Morning America." This ELAN ski has also been adopted by many ski schools.

Applicant began using the mark ELAN BLANC, through a predecessor-in-interest who is a co-owner of the present applicant, in 1979. The mark was first used on hats, and

then expanded to other fashion accessories such as headbands, earmuffs and scarves. The goods are sold throughout the United States in, inter alia, ski stores, sporting goods stores, outdoor stores and hotel gift shops. The primary target for applicant's goods is the ski retailer that carries fashion apparel and accessories.

Sales of ELAN BLANC products rose from \$15,000 or 20,000 in 1979, to a high of \$1 million in 1990, and by 1998 (when the depositions of applicant's co-owners were taken) had fallen to \$500,000. The average retail price for the items is \$30. Applicant does not do any advertising of its goods, although it does exhibit at the annual SIA trade show (the same show at which Monark exhibits). The products have also received some publicity through articles and editorials regarding fashion in magazines such as "Ski" and "Snow Country."

Applicant's witnesses explained that they chose the mark ELAN BLANC because a French name was considered fashionable; they wanted to use an antler design; and perusing a French-English dictionary they found that "elan" was the French word for "elk," and that an elk is a winter animal.

Priority is not in issue in view of opposers' pleaded registrations. See **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The

evidence also shows that opposers have been using the mark ELAN for skis in the United States since prior to applicant's first use of the mark.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to the goods, obviously skis such as opposers sell are different from the hats and other accessories identified in applicant's application. However, it is well-established that the goods of the parties need not be similar or competitive in order to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **In re International Telephone & Telegraph Corp.**, 175 USPQ 910 (TTAB 1978).

The evidence in this case clearly establishes the related nature of opposers' skis and applicant's apparel accessories. The goods are complementary, in that skiers could wear applicant's identified hats, masks and gloves

while skiing, or after skiing. In fact, applicant's catalog has a category of goods called "Apres Ski." Obviously, the class of purchasers for the parties' goods—skiers—is the same. The record also shows that opposers' skis and applicant's apparel accessories are sold or offered in the same retail outlets, such as ski shops and ski rental stores. In addition, applicant's goods are sold in stores in skiing resorts, and gift shops in resort hotels, which would also be frequented by skiers.

Opposers' witness, Robert Orbacz, testified that companies that make skis also sell clothing under the same mark as used on their skis. Mr. Orbacz also testified that opposers' ELAN mark is used on hats, T-shirts, sweatshirts, gloves and sweatpants. We note that opposers did not provide any information as to when sales of clothing began, nor the amount of such sales, nor do any of the extensive advertising materials and catalogs submitted by opposers show use of the mark on clothing. In view thereof, we assume that opposers' use of the ELAN mark on clothing has not been extensive. However, there is documentary evidence to support that opposers do use the mark on clothing (see 1997 SIA directory, Orbacz exhibit 2, listing the brand ELAN and "fleece apparel").

For the foregoing reasons, consumers are likely to believe that both skis and apparel accessories such as hats,

gloves and masks emanate from the same source if they were sold under confusingly similar marks.

We begin our consideration of the parties' marks by noting that opposers' mark ELAN is a strong mark. The years of use, the amount of sales and advertising, the publicity resulting from their development of the parabolic ski, the use of the ELAN parabolic ski in many ski schools, and opposers' number one position for ELAN skis in the rental market persuade us that most experienced skiers, and even many novice skiers, would be exposed to the mark and would recognize it.⁸

In reaching this conclusion, we have considered applicant's witnesses' testimony regarding four asserted third-party uses of ELAN. This testimony is, to say the least, sketchy. Mr. Burr stated that he was aware of a car model called ELAN, although it is not clear whether this mark is still in use. Ms. Burr testified that while in Greece she saw a boat with the trademark ELAN; there is no evidence of this use of the mark in the United States. Ms. Burr also testified about a resort clothing manufacturer called Elan which appeared at the Surf Expo, while Mr. Burr said that he was aware of a swimsuit manufacturer called Elan U.S.A. because it was listed in a catalog for the Orlando Surf Show trade show. It is not clear whether the

witnesses were referring to the same company or two different companies. In any event, there is no information of record as to the amount of sales of any of these companies from which we could conclude that consumers would be aware of their usage of the mark ELAN. Moreover, there is a closer relationship between skis and winter apparel accessories than there is between these goods and the third-party uses.

Opposers' registered marks ELAN and applicant's mark are very similar. Although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the word ELAN is clearly the dominant portion of opposers' marks, since it is by this word that consumers would call for or refer to opposers' skis. **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). Thus, the fact that opposers' registered marks include design elements, and applicant's mark does not, is not sufficient to distinguish the marks. Applicant also asserts that the marks are different in appearance because its mark is in lower case, with an accent mark over the "e", while opposers' is in upper case with no accent mark. However, applicant has

⁸ We do not, however, conclude from the evidence of record that

applied for its mark as a typed drawing, ELAN BLANC (without an accent mark), and therefore the protection of the mark, if it were to be registered, would not be limited to lower case, but would extend to a depiction in upper case, or in the slightly slanted letters shown in one of opposers' registrations. Nor are the slanted letters a distinguishing feature, because it is unlikely that consumers would note or remember them, or remember that the "A" in ELAN is shown at an angle to the other letters. Under actual marketing conditions consumers do not have the luxury to make side-by-side comparisons between marks, and instead they must rely on hazy past recollections. **Dassler KG v. Roller Derby Skate Corporation**, 206 USPQ 255 (TTAB 1980).

The word ELAN, the only word in opposers' marks and the first word in applicant's mark, are identical in appearance and pronunciation. The real question is whether the addition of the word BLANC in applicant's mark is sufficient to distinguish ELAN BLANC from opposers' ELAN marks. Likelihood of confusion has frequently been found when the marks used on related products involve one mark which consists of a single word and another which is comprised of that same word followed by a second term. See, **Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.**, 188 USPQ 105 (CCPA 1975) (BENGAL and

ELAN is a famous mark.

BENGAL LANCER); **Johnson Publishing Company, Inc. v.**

International Development Ltd., Inc., 221 USPQ 155 (TTAB 1982) (EBONY DRUM and EBONE); **Helga, Inc. v. Helga Howie, Inc.**, 182 USPQ 629 (TTAB 1974) (HELGA and HELGA HOWIE).

There is a general rule that a subsequent user may not appropriate another's entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it. **Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.**, 253 F.2d 431, 117 USPQ 213 (CCPA 1958).

Although BLANC is a French word, as applicant's witness Ms. Burr has acknowledged, most consumers would know that it means "white." The color white, of course, is suggestive of snow and is thus suggestive of winter apparel accessories such as the earmuffs, gloves, scarves, etc. identified in applicant's application. Accordingly, the word BLANC in applicant's mark, ELAN BLANC, must be considered subordinate to the word ELAN.

Applicant argues that the meanings of the parties' marks are different, asserting that ELAN is an English word which means "dash" or "style," while ELAN BRANC is French and means "white elk" or "white deer." The dictionary definitions submitted as exhibits to Mr. Burr's deposition shows that "elan" is listed in an English dictionary as meaning "dash; impetuous ardor," and is listed in a French-

English dictionary as meaning, besides "elk, moose", "vigour, spirit, elan." As a result, those consumers fluent in French may well understand ELAN to mean "elk," and ELAN BLANC to mean "white elk," so that the marks would have virtually identical connotations to them. Consumers who are not familiar with the French meaning of ELAN as "elk" will still see the word ELAN in both marks as meaning the same thing, i.e., "dash," and, because of the suggestiveness of BLANC, as discussed above, the addition of this word does not change the basic connotation of the marks. Thus, whether we consider the marks from the standpoint of fluent French speakers, or the public at large, the meanings are very similar.

It must also be remembered that applicant's goods are relatively inexpensive, and would be purchased without a great deal of care by ordinary consumers. Such consumers are not likely to devote a great deal of thought or analysis to the marks in order to determine whether the addition of the word BLANC to ELAN indicates a different source for the accessories than the source for the skis. Rather, given the recognition of opposers' mark ELAN in the sport of skiing, such consumers are likely to simply assume that ELAN BLANC is a trademark of opposers', a variation on their ELAN mark.

Accordingly, we find that all of the duPont factors on which evidence has been submitted favor opposers, and that

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they have met their burden of proving likelihood of confusion. In reaching this conclusion, we have given no weight to the asserted evidence of actual confusion.

Although there was testimony as to a few instances of misdirected mail, it is not clear that this occurred because the sender was confused as to the source of the goods. It could as easily be explained as resulting from the sender's eye slipping to the next listing in a trade directory.

Decision: The opposition is sustained.